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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/670,989	09/25/2003	Michael Wisniewski	106109.62202US	4517

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EXAMINER
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FEENEY, BRETT A

ART UNIT	PAPER NUMBER
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3624

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09/14/2010

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/670,989	<b>Applicant(s)</b> WISNIEWSKI ET AL.	
	<b>Examiner</b> BRETT FEENEY	<b>Art Unit</b> 3624	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 03 March 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-3,6,7,12,17,23,24,34,35,37 and 40-43 is/are pending in the application.
- 4a) Of the above claim(s) 44 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3,6,7,12,17,23-24,34-35,37 and 40-43 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### **Continued Examination under 37 CFR 1.114**

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 03/03/2010 has been entered.

### **Status of the Claims**

2. The following **NON-FINAL** Office Action is in response to Applicant's submission received on 03/03/2010.
3. Claims 1, 12, 23, 34 - 35, 37 and 40 – 43 were amended. Claims 36 and 38 – 39 were canceled. Claim 44 has been withdrawn from consideration.
4. Claims 1 – 3, 6, 7, 12, 17, 23 – 24, 34 – 35, 37 and 40 – 43 are pending and have been examined. Claim 44 is pending and has been withdrawn from consideration.

### **Election/Restriction**

5. New claim 44 is directed to an invention that is independent or distinct from the invention originally claimed for the following reasons:

The original claims were drawn to an embodiment of the instant invention that interactively determines a customer profile based on a customer's response and similarity with other customers that provided similar responses and determines a set of offers to provide to customers sharing the profile.

The amended claims are directed to another embodiment of the instant invention that defines customer profile vectors, matches actions to the vectors and then matches a customer profile to the same.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claim 44 is withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

6. The new claim 44 is directed to another embodiment of the instant invention that is independent or distinct from the invention originally claimed, and would have been restricted if it was presented in the originally filed application.

### **Response to Amendment**

7. Applicant's amendments to the claims are herein acknowledged. As a result of the amendments the Examiner has withdrawn the previous rejections under §112, second paragraph and maintained the previous rejection under §103. Further, the Examiner has entered a new rejection under 35 USC § 112, first paragraph.

### **Response to Arguments**

8. Applicant's arguments received on March 3, 2010 have been fully considered but they are not persuasive. Applicant argues:

- i) Herz does not disclose identifying a selection and presentation order of offers that best fits the customer need and business context for a given profile.
- ii) Claim 44 is allowable over Choi/Holloway/Herz.

In response to argument i) that Herz does not disclose identifying a selection and presentation order of offers that best fits the customer need and business context for a given profile, the Examiner respectfully disagrees. Herz does in fact explicitly recite customizing presentation, order, pricing, etc. to specify customers based on their responses, profile, etc. However, the Examiner respectfully notes, that the Examiner was unable to find support in the instant application for this claimed feature. Accordingly limitation drawn to "identifying a selection and presentation order of offers that best fits the customer need" where rejected under §112, first paragraph. If Applicant disagrees with the Examiners position, Applicant must denote the specific page(s), paragraph(s) and line number(s) where support for the recited limitation is explicitly shown.

In response to argument ii) that Claim 44 is allowable over Choi/Holloway/Herz, the Examiner respectfully notes that this argument is moot because claim 44 is withdrawn from further consideration.

***Claim Rejections - 35 USC § 112***

9. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

10. Claims 1 – 3, 6, 7, 12, 17, 23 – 24, 34 – 35, 37 and 40 – 43 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claim 1, by way of example, recites “analyzing, by the action section module, the distribution of responses to all offers of the set of offers presented to the customers associated with the profile, wherein the analysis identifies one offer an order of selection and presentation of offers of the set of offers that best fits the customer need and the business context for a given profile.” The Examiner is unable to find support in the specification where Applicant describes analyzing a distribution of responses according to an order of selection and presentation of offers of the set of offers and the business context for a given profile. In addition, additional steps that recite “updating the selection and presentation order of offers” do not appear to have support in the specification. Claims depending from claim 1 are rejected

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based on their dependency of the rejected claim. Claims 12, 23 and claims depending therefrom are rejected for similar reasons.

### **Rejections under § U.S.C. 103**

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claims 1 – 3, 6 – 7, 12, 17, 23, 24 and 34 – 43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Choi et al. US 6,895,405 (herein Choi), in view of Holloway et al., US 2003/0033193 (herein Holloway); further in view of Herz et al., US 2001/0014868 (herein Herz).

### **Claim 1**

Choi discloses a computer-implemented method for the optimization of a process comprising:

- *providing a system* (see FIG 9 and associated text in column 29, lines 9-53; noting Choi discloses a computer that contains a storage medium, processor, database, instructions, interfaces and the like.);
- *receiving information about a customer* (see FIG 11 and associated text in column 2, lines 47-67; Noting, customer information is received via a survey.

Further, noting the information from the surveys may be received from another party (i.e. double blinded studies conducted) or "indicat[ed] that a survey variable was important" (i.e. directly from the customer).);

- *wherein the information comprises receiving information directly entered by the customer* (see column 7, lines 11-10; noting individuals taking survey provide information whether they agree or disagree with a statement);
- *matching the information about the customer to a profile stored in the customer profile database based on the customer information (id.* Noting, that the process of segmentation is matching customer responses with others that responded the same. Each cluster is a profile for a group of respondents (i.e. customers).);
- *storing the response in the database* (see FIG 9 and associated text in column 29, lines 9-53; noting, Choi discloses saving responses based on every methodology disclosed in databases.);
- *determining a distribution of customer responses* (see column 5, lines 8-16; Noting "...distributions of about 25% agree/important, 50% neutral/no opinion, 25% disagree/unimportant." Further noting Herz also teaches the same in respect to predicted customer response to offers.);

Choi discloses clustering similar respondents for the purpose of targeted marketing. Choi does not explicitly recite a method for interactive marketing *per se*, however Holloway teaches:

- *repeating the selecting, presenting, receiving and storing steps for the customer and each of a plurality of customers* (see ¶0010; "...the programming



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instructions include instructions for causing the client to parse the data elements from the survey document into data arrays. The data arrays include cross-references defining associations among questions and answers. The arrays provide an efficient data structure by which the applet can follow a chain of cross references and compile, for adding to the survey, branches of sub-questions for particular answers received from a user.”);

Choi/Holloway teaches gathering and analyzing customer data for improved customer marketing. Choi/Holloway does not explicitly recite presenting offers associated with a profile derived from the customer data, however in analogous art Herz teaches:

- *wherein an order of selection and presentation of offers differs between the plurality of customers* (see ¶0250; noting “dynamically generated links between sites may present a joint promotion unique to the user and may combine different vendors and/or their products in different ways.” Further, see also ¶0277; noting [d]ata mining will allow the sales person to identify certain correlations between the present user (and/or his/her unique attributes including domain specific price sensitivity), product/offer affinities, optimal sales pitches (or supplemental materials used in facilitating the sales process), probable statistically predicted next responses of the customer in response to each offer and/or sales pitch, likely additional attributes (e.g. psychographic) which can be inferred about the user based on feedback from the other attribute sources.”);

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- *selecting an offer from a set of offers associated with the profile, wherein each offer in the set of offers is unique, wherein the set of offers comprises a plurality of alternative offers associated with the customer need and a business context* (*id.* Further, see FIG 1 and associated text; noting “Shopper Profile Data”; “Shopper Data Base”, “Offer Data Base”, etc. Further, see ¶0002; noting “[t]he system automatically constructs and updates profiles of a plurality of shoppers based on their demographics and their history of shopping behavior, which history includes both their purchases and their requests for, or reactions to, product information.”).
- *presenting the offer to the customer of the plurality of customers associated with the profile* (*id.* Further see ¶0003; noting “[o]n-line shopping allows further customization, down to the level of the single individual based on “click streams” (the sequence of keys pressed on a computer) or purchase histories of that individual.”);
- *receiving a response to the offer from the customer* (*id.* Noting, “based on their demographics and their history of shopping behavior, which history includes both their purchases and their requests for, or reactions to, product information.”).
- *analyzing, by the action selection module, the distribution of responses to all offers of the set of offers of the set of offers presented to the customers associated with the profile* (*id.* Further see ¶0005; noting “tracking can comprise a number of sources of data to thereby utilize multiple attribute clustering to provide a more powerful analysis capability” (clustering is as method for

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analyzing a distribution of responses)); *wherein the analysis identifies one offer of the set of offers that best fits the customer need and the business context for a given profile (id.* Further noting, “[t]he system can then select, present, price, and promote goods and services in ways that are tailored to an individual consumer.”);

- *updating, by the action selection module, a selection and presentation order of offers of the set of offers in the database based on the analysis of the distribution of responses, wherein future offers presented to customers associated with the profile are selected by the action selection module from the updated database (id.* Further, see ¶¶ 0005-0007; noting “[o]ffers can be profiled as well. Possible attributes for offers include the newness and advertised duration of the offer, the type of product or service being offered, the product's brand name and features, the shoppers who tend to buy the product, other products frequently bought on the same shopping trip, the sales pitch, the price and terms of payment, any discounts provided, and the relative attributes of competing offers. The system of U.S. Pat. No. 5,758,257 describes several techniques that can be used for exploiting these profiles of shoppers (called "users" there) and offers (called "target objects" there).”).

It would have been obvious to a person of ordinary skill in the art, at the time of invention, to combine the computer-implemented method for the optimization of a process taught Choi with the method of interactive marketing taught by Holloway and the step of presenting offers associated with a profile derived from the customer data

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taught by Herz because the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

### **Claim 2**

Choi/Holloway/Herz teaches the limitations above. Furthermore, Choi discloses:

- *wherein matching the information about the customer to a profile further comprises collecting historical information (see at least column 5, lines 35-60; Noting the various data collected on customers pertaining to their responses. Further, see at least column 31, lines 8-19; noting, “historical data”).*

### **Claim 3**

Choi/Holloway/Herz teaches the limitations above. Furthermore, Choi discloses:

- *receiving information about a customer further comprises augmenting the information with information received from external sources (see at least column 3, lines 1-16, noting survey questions are asked of individuals, who are external sources to the marketing firm. Further, see at least FIG 3 and associated text in column 23, lines 25-37; noting initial data is appended based on observational information.).*

### **Claim 6**

Choi/Holloway/Herz teaches the limitations above. Furthermore, Herz teaches:

- *wherein the set of offers is specific to the profile, wherein each offer in the set of offers is selected based on a response forecast, and wherein a response to the offer presented to the customer is used to update the set of action contained in the response forecast (id. at **Claim 1**. Noting offers are profiled and may be tailored to the specific user or any designated level of granularity. Further noting in ¶0007; “[p]redicting the probability that a given shopper will accept a particular offer.).*

It would have been obvious to a person of ordinary skill in the art, at the time of invention, to combine the computer-implemented method for the optimization of a process taught Choi/Holloway/Herz with the step of selecting which offer to present based on a response forecast taught by Herz because the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

## **Claim 7**

Choi/Holloway/Herz teaches the limitations above. Furthermore, Herz teaches:

- *wherein the action database contains a history of responses for each offer, wherein the action selection module analyzes the history of responses associated with the profile in selecting an offer from the set of offers (id. Noting,*

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offers are profiled including historical data that includes how customers responded to offers at a given time, with given terms, discounts and the like.);

It would have been obvious to a person of ordinary skill in the art, at the time of invention, to combine the computer-implemented method for the optimization of a process taught Choi/Holloway/Herz with the step of selecting which offer to present based on a response history taught by Herz because the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

**Claims 12-15, 17, 23, 24, 28 and 29** recite limitations addressed in the claims above and are therefore rejected for similar reasons.

#### **Claim 34**

Choi/Holloway/Herz teaches the limitations above. Furthermore, Choi discloses:

- *wherein the business context is to maximize profit (id. at **Claim 1**. Further, see at least column 19, lines 43-49; noting Choi explicitly discloses practicing the disclosed method to maximize profit.).*

**Claim 40** recites limitations addressed in claim 34 above and are therefore claim 40 is rejected for similar reasons.

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### **Claim 35**

Choi/Holloway/Herz teaches the limitations above. Furthermore, Choi discloses:

- *wherein the business context is to maximize revenue (id. at **Claim 1**. Further, see at least column 19, lines 1-9; noting Choi explicitly discloses practicing the disclosed method to maximize revenue.).*

### **Claim 37**

Choi/Holloway/Herz teaches the limitations above. Furthermore, Choi discloses:

- *wherein the offer presented to a customer is selected from the set of offers based on the price, wherein the price is below the customer's willingness to pay (Id. Further, see at least column 8, lines 1-14; noting, Choi teaches econometric customer profiling based on a plurality of data including product price and customer's willingness to pay (i.e. purchase) a product given a set of alternatives.).*

### **Conclusion**

The references cited in the form PTO-892 were not applied under relevant sections of §102 or §103 in the above Office action, however they are considered relevant to both claimed and unclaimed features of the instant invention. Applicant is herein advised to review the cited prior art references prior to responding to the instant Office action in order to expedite prosecution of the instant application. For example, the

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following references are considered particularly relevant to the instant claimed invention:

- Ananian, US 2003/0028451; discloses an interactive digital catalog of products, service and information that is responsive to personalized and/or profiled content.
- Srider et al., US 2003/0208754; discloses a system and method for predictively profiling customers based on customer behaviors, historical transactions and similarly profiled customers, etc. and dynamically presenting content to the customers based on the profiled information.

Any inquiry of a general nature or relating to the status of this application or concerning this communication or earlier communications from the Examiner should be directed to **BRETT FEENEY** whose telephone number is **571.270.5484**. The Examiner can normally be reached on Monday-Thursday, 7:30am-6:30pm. If attempts to reach the examiner by telephone are unsuccessful, the Examiner's supervisor, **Lynda Jasmin** can be reached at **571.272-6782**.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://portal.uspto.gov/external/portal/pair> . Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at **866.217.9197** (toll-free).



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